



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,535	01/22/2002	Keith G. Copeland	97,008-X	7198

20306 7590 10/30/2002

MCDONNELL BOEHNEN HULBERT & BERGHOFF
300 SOUTH WACKER DRIVE
SUITE 3200
CHICAGO, IL 60606

EXAMINER

BEX, PATRICIA K

ART UNIT	PAPER NUMBER
	1743

DATE MAILED: 10/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/054,535	COPELAND ET AL.
Examiner	Art Unit	
P. Kathryn Bex	1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 18 October 2002 .

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 72-98 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 72-98 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 22 January 2002 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. ____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). ____ .
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1-4
6) Other:

DETAILED ACTION

1. The cancellation of claims 1-71 is acknowledged and has been entered into the record.

Drawings

2. The drawings are objected to because Figures 18A-18C are not referenced in the Brief Description of Drawing section. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 72-87, 90-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heidt *et al* (USP 5,250,262) in view of Sakurada (USP 4,346,056).

Heidt *et al* teach a chemical analyzer utilizing a method of dispensing reagents (e.g.

serum) onto a slide 71. The method comprises the steps of providing a reagent container containing serum and providing a slide on a slide carousel 50. Additionally, Heidt *et al* teach automatically determining whether the serum in the pipetter 16 should be dispensed onto the slide by reading, via BCR 158, the information contained on the barcode 86 of the slide (column 15, lines 20-24, column 30, lines 33-49). Additionally, Heidt *et al* teaches determining the position of a slide relative to a home position (column 26, lines 40-68.) Heidt *et al* fail to teach the step of automatically identifying the reagent using a computer, based on information associated with the reagent container.

Sakurada does teach the step of automatically identifying the reagent using a computer, based on information associated with the reagent container 7. Sakurada discloses providing a bar-code reader 31 for reading a reagent bar-code 33 on the reagent container and sending the reagent information to a control device 24 (column 3, line 12- column 4, line 38). Additionally, Sakurada teaches determining the position of the reagent container on a carousel and sending that position information to the computer (column 5, line 67- column 6, line 5, Figs. 3, 5-8).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to have substituted the manual method of Heidt *et al* of inputting reagent information into the computer with the step of automatically inputting the reagent information into a computer in order to reduce the possibility of data entry errors associated with manual data entry. Moreover, it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Art Unit: 1743

6. Claims 88-89, 92-98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heidt *et al* (USP 5,250,262) and Sakurada (USP 4,346,056), as applied to claim 72, in further view of Rokugawa (USP 4,844,868).

Heidt *et al* and Sakurada as previously discussed above do not teach the step of moving the reagent container and slide support relative to one another to position the reagent container over the slide. Rokugawa does teach an apparatus for delivering reagent to reaction containers wherein a plurality of reagents 68 are supported on a reagent carousel 64 which is positioned above a reaction carousel. A reagent delivery actuator means 100 for engaging a reagent container and initiating delivery of reagent (Fig. 1). The positioning of the reagent delivery system over the reaction carousel reduces distribution time and reduces the possibility that cross contamination will occur (column 6, lines 8-14).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to have positioned the reagent delivery system of Heidt *et al* and Sakurada over the reaction carousel, as taught by Rokugawa, in order to reduce distribution time and possibility that cross contamination will occur.

Conclusion

7. No claims allowed.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Bex whose telephone number is (703) 306-5697. The examiner can normally be reached on Mondays-Thursdays, alternate Fridays from 6:00 am to 3:30 pm EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 308-4037.

Art Unit: 1743

The fax number for the organization where this application or proceeding is assigned is (703) 872-9310 for official papers prior to mailing of a Final Office Action. For after-Final Office Actions use (703) 872-9311. For unofficial or draft papers use fax number (703) 305-7719. Please label all faxes as official or unofficial. The above fax numbers will allow the paper to be forwarded to the examiner in a timely manner.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Kathryn Bex

P. Kathryn Bex
Patent Examiner
AU 1743
October 29, 2002

Jill Warden
Jill Warden
Supervisory Patent Examiner
Technology Center 1700